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| TRASK BRITT<br>P.O. BOX 2550<br>SALT LAKE CITY, UT 84110 |             |                       | EXAMINER<br>LONG, SCOTT |                  |
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/618,526  
Filing Date: July 11, 2003  
Appellant(s): FALLAUX ET AL.

David V. Trask and Allen C. Turner  
For Appellant

**SUPPLEMENTAL EXAMINER'S ANSWER**

This is in response to the appeal brief filed 03 July 2007 appealing from the Office action mailed 27 March 2007, and corrects an omission from section 8 in the Examiner's Answer filed 28 August 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows. The provisional rejection of claims 1, 3-7, 16, 21, and 25 under the judicially created doctrine of obviousness-type double patenting over application 10/036,949, which has since issued as US 7,029,848, was withdrawn in the Office action of 06 November 2006. Consequently, there is no outstanding rejection over the '848 patent. The only outstanding rejection of claim 21 is provisional, and not a subject of the appealed rejection.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(8) Evidence Relied Upon**

|           |               |         |
|-----------|---------------|---------|
| 6,340,595 | Vogels et al. | 01-2002 |
| 6,413,776 | Vogels et al. | 07-2002 |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-7, 10, 11, 16, 22, and 25 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over: claims 43 and 44 of U.S. Patent No. 6,340,595 and claims 7, 32, and 35 of U.S. Patent No. 6,413,776.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly adenoviral packaging cells embrace the packaging cells used in the methods of claims 43 and 44 of the '595 patent and the cells used in the method of claims 7, 32, and 35 of the '776 patent.

**(10) Response to Argument**

Appellant's comments and arguments at pages 5-10 of the Brief do not appear to identify any impropriety of the rejection at issue, except for whether the application of a "one-way" patentability test was proper, which is argued at pages 10-11. Rather the comments appear to be directed to whether current USPTO practice as set forth in MPEP 804 is reasonable and equitable with respect to making an obvious-type double patenting rejection in a situation where there would be no time-wise extension of monopoly or where the application and reference patent or application are not commonly assigned.

With respect to the former, Appellant argues that the primary basis for the judicial doctrine of obvious-type double patenting is to prevent a time-wise extension of monopoly, and

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that preventing possible harassment by multiple assignees is merely secondary and not sufficient basis on its own. In response, it remains that preventing possible harassment by multiple assignees is a basis for the doctrine. Indeed, the present situation, in which the conflicting applications are no longer commonly owned, is one situation this doctrine was intended to prevent.

With respect to the latter, Appellant appears to argue that since the instant assignee does not own the reference patents and consequently a terminal disclaimer cannot be filed, the judicial doctrine does not apply. In response, 37 CFR 1.321 provides one avenue for overcoming an obviousness-type double patenting rejection where the conflicting applications are commonly owned. It does not logically follow from this rule that lack of common ownership obviates an obviousness-type double patenting rejection. Furthermore, the applications of the reference patents had been commonly assigned with the parents of the instant application.

At pages 10 and 11 of the Brief, Appellant argues that application of a “one way” patentability test is improper, citing in *In re Braat*, 19 USPQ2d 1289 (Fed. Cir. 1991). Appellant points out that as in the instant case, the Braat application was filed after the reference patent (Dil), but based upon applications filed prior to that of the reference patent, and that the Dil patent was a non-obvious improvement of the invention of Braat. In response, the court more explicitly explained in *In re Emert*, 44 USPQ2d 1149, 1152 (Fed. Cir. 1997) that application of the two-way test in *Braat* was appropriate because two conditions were met: the claims of Dil could not have been presented in the Braat applications *and* “applications for basic and improved patents should not be penalized by the rate of progress of the applications through the PTO, a matter over which the applicant does not have complete control,” citing *Braat* at 1292, i.e.

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Braat's application's also met the second requirement for applying the "two-way" test, i.e. administrative delay in prosecution by the PTO over which Braat had little control. Also see MPEP 804 section II.B.1.(b). The instant application meets the first condition but not the latter.

Appellant does not argue or provide evidence that the issuance of the '595 and '776 patents prior to the instant application was due to administrative delay on the part of the PTO. The instant application was filed on 7/11/03, which was after the issuance of both the '595 and '776 patents. Prior to filing the instant application and more importantly prior to the issuance of the '595 and '776 patents, Appellant had been issued US Pat. No. 5,994,128, from which the instant application descends, and US Pat. Nos. 6,033,908; 6,265,212; 6,306,652; and 6,395,519, which also descend from the '128 patent. Each of the '128, '908, '212, '652, and '519 patents have been terminally disclaimed in the instant application in response to obviousness-type double patenting rejections. There is no evidence of record that the PTO prevented Appellant from including the instant claims in any of these earlier patents during their prosecution. This earlier issuance of patents over which the instant claims were obvious under obviousness-type double patenting doctrine shows that there was no administrative delay by the PTO that caused earlier issuance of applications with later effective filing dates. The instantly claimed subject matter could have been claimed and been issued in any of these earlier patents. Appellant has been solely in control of the delay in prosecution of the instant claims. Consequently, the "one-way" patentability test is applicable here, not the "two-way" test.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Scott D. Priebe/

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